

STATEMENT SHOWING UNAVOIDABLE DELAY

The evidence of record reveals that petitioner, Richard Brown (“Richard”), took several steps to ensure timely payment of the eighth year maintenance fee of U.S. Patent No. 6,079,668 (“the ‘668 patent”). Specifically, Richard retained attorneys for prosecuting the ‘668 patent and those attorneys assured Richard that they would monitor the ‘668 patent after issuance. He also moved several times, but he made sure to update his correspondence address with the USPTO soon after moving so that he would receive reminders about the maintenance fees for the ‘668 patent. Richard even paid the Canadian Post Office to forward his mail from his old address to his current address so that he would receive maintenance fee reminders. Despite taking these steps, neither Richard nor anyone affiliated with his company received a reminder to pay the eighth year maintenance fee, making timely payment of the maintenance fee unavoidable. Furthermore, once Richard discovered the abandonment of the ‘668 patent, Richard promptly took steps to file this petition to revive the ‘668 patent.

Richard Took Several Steps to Ensure Timely Payment of Maintenance Fee

Richard invented the Portable Helipad disclosed in the ‘668 patent. See accompanying *Declaration of Richard Brown*, ¶ 1. Richard relied on his attorneys at Barrigar & Moss for guidance during prosecution of the patent and, once the patent issued, he similarly relied on his attorneys to provide reminders about maintenance fees for the patent. *Id.* at ¶¶ 4, 7. However,

unbeknownst to Richard, Barrigar & Moss dissolved before the eighth year maintenance fee came due. *Id.* at ¶¶ 8, 9.

Moreover, Richard's business, Touchdown Enterprises, Ltd. ("Touchdown Enterprises") changed addresses multiple times, before and after the '668 patent issued. *Id.* at ¶¶ 13, 15. Richard made sure to update the correspondence address at the USPTO each time Touchdown moved. *Id.* at ¶¶ 14, 16. Richard even went so far as to pay the Canadian Post Office for mail forwarding so that correspondence would be delivered to his current address. *Id.* at ¶ 21. However, neither he nor anyone affiliated with Touchdown ever received a reminder about the eighth year maintenance fee. *Id.* at ¶ 20.

In re Mattullath, 38 App. C.C. 497, 514-15 (1912) explains that:

[t]he word "unavoidable"... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In the present case, Richard reasonably relied on several entities (i.e., his attorneys, the Canadian Post Office, and the USPTO) for providing reminders about the due date for the eighth year maintenance fee. However, no such reminder was received, resulting in an unavoidable delay in payment of the eighth year maintenance fee.

USPTO Failure to Update Correspondence Address Particularly Caused Unavoidable Delay

As noted above, the USPTO failed to update Touchdown's correspondence address. *Id.* at ¶ 16-19. Where abandonment occurs as a consequence of an erroneous correspondence

address, an adequate showing of "unavoidable" delay will require a showing that: (1) due care was taken to adhere to the requirement for prompt notification in each concerned application of the change of address; and (2) must include an adequate showing that a timely notification of the change of address was filed in the application concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address. MPEP 711.03(c). It is noted that MPEP 711.03(c) relates to unavoidably abandoned patent applications; however, the unavoidable delay standard for maintenance fees is considered under the same standard for reviving an abandoned application. MPEP 2590. See e.g., *Ray v. Lehman*, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting *In re Patent No. 4,409,763*, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), *aff'd sub nom. Rydeen v. Quigg*, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), *aff'd*, 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992)).

Here, there was a clear pattern of providing timely notification of the change of correspondence address for the '668 patent. Specifically, in June, 1999, the correspondence address was changed from Barrigar & Moss's address, to Touchdown's address in Gold River, B.C. *Declaration of Richard Brown*, ¶ 12. Then, only about 3 months elapsed before filing another Correspondence Address Change Request. *Id.* at ¶¶ 13, 14. Additionally, in the same month that Touchdown changed addresses, a third Correspondence Address Change Request was filed with the USPTO. *Id.* at ¶¶ 15, 16. Accordingly, it is clear that the USPTO was promptly informed each time that the correspondence address changed for the '668 patent.

Moreover, the third Correspondence Address Change Request was made in the same manner as the first and second Address Change Requests. *Id.* at ¶ 17. Since the first and second Address Change Requests resulted in successful and accurate changes to the correspondence address, it is reasonable to assume that the third Correspondence Address Change Request was

made “in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address.”

Despite the filing of the third Address Change Request, the USPTO never changed correspondence address for the ‘668 patent. *Id.* at ¶ 18, 19. Accordingly, Richard never received the reminder to pay the eighth year maintenance fee for the ‘668 patent, and thus timely payment of the maintenance fee became unavoidable.

Lack of Reminder Resulted in Unavoidable Delay

In *In re Patent No. 4,409,763*, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), the Commissioner holds that the lack of receipt a maintenance fee reminder notice will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the PTO. However, the present case is very different.

In *In re Patent No. 4,409,763*, the patentee’s attorney failed to update his correspondence address for the patent at issue. As a result, the PTO’s maintenance fee reminder was mailed to an outdated address. The patentee argued, in part, that this caused unavoidable delay in paying his maintenance fee. See *id.*

In contrast, in the present case, Richard diligently updated the USPTO when his business’ address changed. Despite Richard’s efforts, the USPTO failed to change the correspondence address, and Richard never received the eighth year maintenance fee. This, combined with the dissolution of Barrigar & Moss and the resulting lack of maintenance fee reminder from Richard’s attorney, caused the unavoidable delay in paying the maintenance fee.

Petitioner Promptly Took Corrective Action Upon Discovery of Abandonment

An Applicant seeking to revive an “unavoidably” abandoned patent must promptly act to revive the patent upon becoming aware of its abandonment. Here, as soon as Richard became aware that the maintenance fee was left unpaid and the ‘668 patent was abandoned (i.e., on or about April 25, 2012), corrective steps were promptly taken. Specifically, Richard’s wife called the USPTO only one day later to determine how to revive the ‘668 patent. *Id.* at ¶¶ 22, 23. Then, Richard waited only one additional day to call attorneys John Dawson and Thomas Vesbit for assistance in reviving the ‘668 patent. *Id.* at ¶ 24. Finally, Mr. Dawson and Mr. Vesbit prepared and filed the present petition as soon as their schedules permitted. *Id.* at ¶ 25. Accordingly, it is clear that Richard attempted to promptly revive the ‘668 patent once the abandonment was discovered.

Conclusion

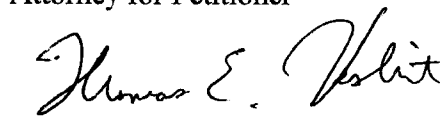
As detailed above, Richard took several steps to ensure timely payment of the eighth year maintenance fee for the ‘668 patent, but the delay in payment became unavoidable due to the dissolution of Barrigar & Moss and the failure on the part of the USPTO to update Richard’s correspondence address. Also, Richard promptly acted to revive the ‘668 patent by filing this

petition as soon as possible. Accordingly, Richard respectfully requests acceptance of the overdue eighth year maintenance fee and revival of the '668 patent.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.L.C.
Attorney for Petitioner

Dated: May 18, 2012

A handwritten signature in cursive script, reading "Thomas E. Vesbit". The signature is written in dark ink and is positioned above a horizontal line.

Thomas E. Vesbit, Reg. No. 50,562

P.O. Box 828
Bloomfield Hills, MI 48303
(248) 641-1600